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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,363	08/01/2000	Achim Pietig	048662/0125	2240

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EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/601,363

Applicant(s)

PIETIG, ACHIM

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 01 August 2000 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 6) ☐ Other:

DETAILED ACTION

Receipt is acknowledged of the preliminary amendment filed on 8/1/2000. The claim amendments have been entered, however, the amendments to the specification have not been entered, since the page and line numbers do not correspond to the specification. Claims 13-24 are pending. Receipt is acknowledged of the IDS filed on 10/16/2000, the Canadian patent 1172542 has been lined through, since it is directed to a lawn umbrella and does not appear to have any relevance to the instant invention. It is noted that the PCT search report indicates that the Canadian patent is an equivalent to WO 9638814 A, while the Canadian patent has the same patent number listed in the search report, the publication date does not match.

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 8/1/2000 have been disapproved. The drawings filed in the application have already been translated into English, and provide a more complete description than that provided in the proposed drawing corrections.

Specification

2. The disclosure is objected to because of the following informalities:

The specification does not contain headings. Headings, such as "BACKGROUND OF THE INVENTION", "BRIEF SUMMARY OF THE INVENTION", "BRIEF DESCRIPTION OF THE DRAWINGS", and "DETAILED DESCRIPTION OF THE INVENTION", should be added to the specification.

The specification does not contain a brief description of the drawings. (It is noted that the preliminary amendment contains amendments to add headings and a brief description of the drawings, however, as mentioned above, these amendments have not been entered).

Appropriate correction is required.

Claim Objections

3. Claims 13, 20, and 24 are objected to because of the following informalities:

Claim 13:

Line 3, "an" should be replaced with --a--.

Line 5, "an" should be replaced with --a--, and "said" should be deleted, since the claim reads, "said the portable data medium".

Claim 20, line 4: "contactiess" should be replaced with --contactless--.

Claim 24:

Line 12, the second occurrence of "one of said various" should be deleted.

Lines 13-14, due to the use of parenthesis, it is unclear as to whether the phrase "(an access command transmitted by the data input/data output unit is executed)" is intended to be part of the claimed invention. For examination purposes, the claim has been interpreted so as not to require "(an access command transmitted by the data input/data output unit is executed)".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 13-20, 23, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Reiner et al (US 5,875,450, cited by applicants).

Reiner et al teaches a portable microprocessor-assisted data medium (a chip card with microprocessor 9) able to be operated in both contacted and contactless fashion, and a method for carrying out communication between a portable microprocessor-assisted data medium and a data input/data output unit operating in contacted fashion or a data input/data output unit operating in contactless fashion comprising: a structure (a first interface 1 with contacts, see column 3 line 57 - column 4 line 5) for carrying out a contacted mode, in which the portable data medium and a data input/data output unit (not shown) transmit data to each other in a contacted fashion, a structure (a second interface 2 formed, for example, by a coil, see column 4 lines 6-17) for carrying out a contactless mode, in which the portable data medium and the data input/data output unit (not shown) transmit data to each other in a contactless fashion, the portable data medium has at least one memory area (memory 5) divided into

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various memory areas, such that the portable data medium stores (the switching logic may be a ROM, PROM, EPROM, or EEPROM, see column 3 lines 17-26 and column 5 lines 6-18) at least one access condition for at least one memory area (transmission of address, control and data signals fed in through the first interface 1, only takes place when an identification or authentication procedure has been carried out between the device for processing and storing data and a terminal or a user of the device, see column 4 lines 40-53), the access condition defines the condition (identification or authentication has been established) under which access to the memory area is permitted, also, the portable data medium stores at least one data transmission-specific access condition for at least one memory area (memory areas which can be accessed only through the first interface with contacts, and memory areas which can be accessed only through the contactless second interface, see column 2 lines 27-37), the access condition defines the basis of the type of data transmission (contact or contactless) between the portable data medium and a data input/data output unit and the condition under which access to this particular memory area is permitted, wherein a data transmission-specific access condition for the contactless mode is provided for at least one memory area, the access condition prohibiting any access to this particular memory area in the portable data medium's contactless mode (memory areas which can only be accessed by the first interface can not be accessed in the contactless mode, by the second interface), wherein a data transmission-specific access condition for the contactless mode is provided for at least one memory area (the money value memory area), the access condition defining different conditions under which access is permitted

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for each of at least two different access types (writing which increases the value of money stored in the memory, and writing which decreases the value of money stored in the memory) in the portable data medium's contactless mode, wherein various access types (writing access which increases the value of money stored in the memory, or writing access which decreases the value of money stored in the memory) are allocated different data transmission-specific access conditions for a memory area for the contactless mode, the access conditions defining the conditions under which access is permitted for the respective access type in the portable data medium's contactless mode (for example: a writing access which increases the value of money stored in the memory is possible only by the type of transmission with contacts, see column 2 lines 43-46), wherein a data transmission-specific access condition for the contacted mode is provided for at least one memory area, the access condition prohibiting any access to this particular memory area in the portable data medium's contacted mode (memory areas which can only be accessed by the second interface can not be accessed in the contact mode, by the first interface), wherein a data transmission-specific access condition for the contacted mode is provided for at least one memory area (the money value memory area), the access condition defining different conditions under which access is permitted for each of at least two different access types (reading, and writing which increases the value of money stored in the memory) in the portable data medium's contacted mode, wherein various access types (reading, writing, or specific forms thereof) are allocated different data transmission-specific access conditions for a particular memory area for the contacted mode, the access conditions defining the

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conditions under which access is permitted for the respective access type in the portable data medium's contacted mode, wherein for at least one memory area (the money value area) and for at least one access type (writing access which increases the value of money), one data transmission-specific access condition is provided for the contacted mode (writing access which increases the value of money is permitted in the contact mode) and one data transmission-specific access condition is provided for the contactless mode (writing access which increases the value of money is not permitted in the contactless mode), checking before the particular one of the various memory areas is accessed (the money value memory area), whether in consideration of the data transmission-specific access condition (whether increasing the value of money is permitted or not), the desired access command is permitted given the particular current type of data transmission (contact or contactless), and executing the access command only if the result of the check is that access is permitted, wherein the data transmission-specific access condition is stored in a non-modifiable read only memory in the portable data medium (a ROM, see column 5 lines 6-9) (also see the figure, column 1 lines 10-19, column 35-65, column 2 lines 6-60, column 3 lines 17-26, 44-53, column 3 line 57 - column 4 line 17, column 4 lines 40-53, and column 5 lines 6-18).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiner et al.

The teachings of Reiner et al have been discussed above. Reiner et al also teaches the data transmission-specific access condition can be input/reprogrammed into a freely programmable nonvolatile memory (an EPROM or EEPROM) in the portable data medium by authorized agencies (see column 3 lines 17-25 and column 5 lines 6-13).

Reiner et al fails to specifically teach the data transmission-specific access condition being input/reprogrammed using an item of secret information.

However, Reiner et al also teaches transmission of address, control and data signals fed in through the first interface 1, only taking place after an identification or authentication procedure (which includes an item of secret information such as an authentication code or PIN) has been carried out between the device for processing and storing data and a terminal or a user of the device (see column 4 lines 40-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Reiner et al, the data transmission-specific access condition being input/reprogrammed using an item of secret information, in order to increase the security of the system.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kobayashi et al (US 6,375,082 B1), Berger et al (US 6,168,083 B1), Bashan et al (US 6,161,762), Thuringer et al (US 6,145,749), Kreft et al (US

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6,098,890), Bashan et al (US 6,045,043), Kowalski (US 6,003,777), Reiner et al (US 5,999,713), Kreft (US 5,206,495), Kreft (WO 97/08929), and (JP 2000-123139) all teach IC cards having contact and non-contact modes. Locher et al (US 6,126,078), Kreft (US 5,847,372), Bournas (US 5,452,431), Takagi et al (US 5,408,082), Iijima (US 5,161,256), all teach IC cards with different memory areas having different access requirements/restrictions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jared J. Fureman
Jared J. Fureman
August 24, 2002